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PTOL-90A (Rev. 04/07)

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte EDWIN C. ILIFF

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Appeal 2009-004403
Application 09/785,044
Technology Center 2100

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Before JAMES T. MOORE, *Vice Chief Administrative Patent Judge,*
JOHN A. JEFFERY, LANCE LEONARD BARRY, THU A. DANG, and
JAMES R. HUGHES, *Administrative Patent Judges.*

DANG, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING[1]

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[1] The two-month time period for filing an appeal or commencing a civil
action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing,
as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE"
(paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery
mode) shown on the PTOL-90A cover letter attached to this decision.

I. STATEMENT OF THE CASE

Appellant has filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(1) (hereinafter "Request") on May 24, 2010, for reconsideration of the Decision mailed March 23, 2010 (hereinafter "Decision") with respect to claim 6 (Request 1).

The Decision affirmed the Examiner's rejections of claims 6-10, 20-42, and 49-51 under 35 U.S.C. § 101, of claims 6-9, 20-27, 29-38, 40-42, and 49-51 under 35 U.S.C. § 102(b), and of claims 1-5, 10-19, 28, 39, 43-48, and 52 under 35 U.S.C. § 103(a). The Request only addresses the affirmance of the rejection of claim 6 under 35 U.S.C. § 102(b) over Iliff, and thus, the affirmance of the other rejections, including the rejection of claim 6 under 35 U.S.C. § 101, is not the subject of this Request (Request 1-8).

We have reconsidered the panel's Decision of March 23, 2010 regarding claim 6 under 35 U.S.C. § 102(b) over Iliff, in light of Appellant's comments in the Request, and we find Appellant has not identified any points misapprehended or overlooked by the Board in the Decision to affirm the rejection of claim 6 under 35 U.S.C. § 102(b). We decline to change the Decision for the reasons discussed *infra*.

II. ISSUE

The issue we address on this Request is whether Appellant has identified any points misapprehended or overlooked by the Board in holding claim 6 anticipated by Iliff.

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III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Final Office Action

1.   In the Final Office Action, the Examiner found that Iliff discloses diagnostic objects because "each diagnosis [is] associated with symptoms in MDATA system" and "the MDATA system is written in object-oriented program language, such as C++" (Fin. Rej. 5).

Appeal Brief

2.   In the Appeal Brief, Appellant merely stated that "[p]rogramming in an object oriented language such as C++ is a general technological tool that is different than precisely specifying the diagnostic objects recited in Claims[sic] 6" without explaining as to why it is different (App. Br. 18).

Examiner's Answer

3.   In the Examiner's Answer, the Examiner repeated that Iliff discloses diagnostic objects because "each diagnosis [is] associated with symptoms in MDATA system" and "the MDATA system is written in object-oriented program language, such as C++" (Ans. 11), and pointed out that Appellant "failed to clarify how prior art C/C++ object oriented language tool is different from instant application object oriented language in specifying diagnostic objects recited in the claim 6" (Ans. 24).

Reply Brief

4. In the Reply Brief, the Appellant added the argument that, since the Specification defines the term "object," "Iliff does not disclose the object implementation as defined by Appellant" (Reply. Br. 6-7).

IV. ANALYSIS

We note that Appellant does not request reconsideration of our affirmance of the Examiner's rejection of claim 6 under 35 U.S.C. § 101. Accordingly, we still find claim 6 unpatentable under 35 U.S.C. § 101, wherein Appellant has not identified any points misapprehended or overlooked by the Board in the Decision concerning this rejection.

Though Appellant does not request reconsideration of the finding of unpatentability of claim 6, we will nevertheless address the points set forth in the Request.

In the Request, Appellant contends that "[s]ince the arguments entitled *Iliff Does not Disclose the Particular Objects of Claim 6 and Their Interaction* (pages 6-8) was indeed raised in a reply brief, it cannot be subject to waiver" (Request 2). We agree with Appellant that 37 CFR § 41.37(c)(1)(vii)(2004) states that any argument "not included in the brief or a reply brief filed pursuant to 41.41 will be refused consideration by the Board..." (Request 2; emphasis added); however, as we set forth in our Decision, it is inappropriate for Appellant to discuss for the first time in the Reply Brief matters that could have been raised in the Appeal Brief (Decision 14). That is, "[t]he failure to raise all issues and arguments

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diligently, in a timely fashion, has consequences," and thus, such newly-raised arguments are technically waived. *Ex parte Borden*, 93 USPQ2d 1473, 1475 (BPAI 2010) (informative decision) ("[The reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not."). *Cf. Kaufman Company v. Lantech, Inc.*, 807 F.2d 970, 973 n.* (Fed. Cir. 1986) and *McBride v. Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986).

In the Final Rejection, the Examiner found that Iliff discloses diagnostic objects because Iliff discloses diagnosis in a MDATA system that is written in object-oriented C++ language (FF 1). Appellant attempted to distinguish Iliff by stating, in the Appeal Brief, that programming in C++ is different than specifying the diagnostic objects recited in claim 6 (FF 2). Appellant, however, provided no explanation as to how or why specifying the diagnostic objects is different from the disclosure of Iliff. Here, Appellant is simply quoting the claim language, which we find to be a mere general allegation of patentability that does not specify, as required, how the quoted language patentably distinguishes the claimed invention. This form of argument in the Appeal Brief is wholly ineffective in demonstrating error in the Examiner's prima facie case to establish the patentability of the claims on appeal. *Ex parte Belinne*, Appeal No. 2009-004693, decided Aug. 10, 2009, (BPAI) (informative). Accordingly, this omission of explanation was noted by the Examiner in the Answer (FF 3).

In the Reply Brief, Appellant then added additional arguments in an attempt to cure the noted deficiencies in the Appeal Brief. We find these arguments are new arguments raised for the first time in the Reply Brief. The Examiner presented the basis for the rejection in the Final Rejection, and maintained the rejection on the same basis in the Answer (FF 1 and 3). Appellant's arguments could have been raised in the Appeal Brief, but Appellant failed to do so.

Although such newly-raised arguments are technically waived, the previous panel nevertheless considered Appellant's belated arguments in the Reply Brief, but found them unpersuasive (Decision 14). As the panel indicated in the Decision, "even assuming arguendo that the 'Terminology Section' defines 'objects' in a manner distinguishing over Iliff [as set forth in the Reply Brief]" (*id.*, emphasis added), the panel still found the argument unpersuasive. That is, as was stressed in the Decision, "we see no reason to limit the recited 'objects' in accord with Appellant's Reply Brief argument" (*id.*, emphasis added).

Thus, since the panel considered Appellant's arguments in the Reply Brief, Appellant has not identified any points misapprehended or overlooked by the Board in the Decision regarding this point.

Appellant also argues in the Request that "[t]he Board has improperly interpreted the term 'object' in an unreasonable way that is entirely not consistent with the specification" (Request 4). As set forth in the Decision, the panel broadly interpreted "objects" as having "a hierarchical relationship such that the result of one of the objects is input to another of the objects," as

<u>defined</u> in claim 6 (Decision 13). The panel did not read limitations into the claims from the specification. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Instead, the panel defined the term "object" by its plain meaning, <u>consistent with the specification</u>, and agreed with the Examiner that "objects" are disclosed in Iliff's MDATA system that is written in <u>object-oriented</u> C++ language (Decision 12-14).

Accordingly, the panel found that Iliff's nodes comprise objects "having 'a hierarchical relationship such that the result of one of the objects is input to another of the objects' and as directly invoking, e.g., calling or passing control/data to, one another 'so as to output a diagnosis of a patient'" (Decision 14). Thus, while the panel did not import matter from the specification to interpret claim 6 in the Decision, the panel nonetheless relied upon the definition of the disputed term provided in Appellant's claim. The panel also considered the ordinary meaning of the disputed term consistent with the Specification in construing the term.

Thus, Appellant has not identified any points misapprehended or overlooked by the Board in the Decision regarding this point.

In the Request, Appellant also argues that the Board erred because "[t]he Board agreed with the Examiner that the diagnostic objects are 'not precisely specified' in Appellant's specification" (Request 5). However, Appellant has mischaracterized the Board's Decision. That is, as set forth in the Decision, "[c]ontrary to Appellant's argument, <u>claim 6</u> does not 'precisely specify[] the diagnostic objects'" (Decision 12, citing App. Br.

17-18; emphasis added). Here, the panel found that the <u>claim</u> did not further define the term, not – as stated by Appellant – the specification that did not define the term.

The panel considered all of the claim limitations, including descriptive material, when determining patentability of Appellant's invention over the prior art. *See In re Gulack,* 703 F.2d 1381, 1385 (Fed. Cir. 1983). However, here, the panel declined to give patentable weight to descriptive material that did not have a new and obvious functional relationship with the underlying data (substrate) (i.e., nonfunctional descriptive material). *See Gulack,* 703 F.2d at 1386; *see also In re Ngai,* 367 F.3d 1336, 1338 (Fed. Cir. 2004); *King Pharm., Inc. v. Elan Pharm., Inc.,* No. 2009-1437, slip op. at 17-22 (Fed. Cir. Aug. 2, 2010).

As explained in the Decision, "claim 6 merely recites the 'diagnostic object' as comprising 'a disease object, a symptom object, a valuator object, a question object, a node object and a candidates object'" wherein "labels 'diagnostic,' 'disease,' 'symptom,' 'valuator,' 'question,' 'node,' and 'candidates' are 'nonfunctional descriptive' material" (Decision 12). The panel found that there is no functional relationship between the various labels and the objects defined in the claim. In fact, even Appellant admits that these terms are "adjectives that refer to specific types of diagnostic objects" without pointing to any function given to these terms by the claim (Request 6). As set forth in the Decision, the claimed "objects" read on any diagnosis object since the non-functional descriptive labels do not

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distinguish the invention from Iliff in terms of patentability (Decision 12-13).

Thus, Appellant has not identified any points misapprehended or overlooked by the Board in the panel's Decision regarding this point.

In the Request, Appellant further argues that "[t]he Board has also erred in finding that the 'nodes' disclosed in Iliff '669 correspond to Appellant's claimed 'objects'" (Request 7). As discussed above, the panel defined "object" by its plain meaning, consistent with the specification, and agreed with the Examiner that "objects" are disclosed in Iliff's MDATA system that is written in object-oriented C++ language (Decision 12-14).

Accordingly, the panel found that Iliff's nodes comprise the claimed objects (Decision 12-13). Thus, the panel did not import matter from the specification in interpreting the claims in the Decision as Appellant suggests, but relied upon the definition of the term provided in Appellant's claim. In other words, the panel considered the term's ordinary meaning consistent with the Specification.

Thus, Appellant has not identified any points misapprehended or overlooked by the Board in the Decision regarding this point.

Accordingly, Appellant's Request does not persuade us of any points we misapprehended or overlooked in the Decision, nor does Appellant's Request persuade us to reverse the Examiner's rejection of claim 6 over Iliff. Furthermore, as discussed above, Appellant does not request reconsideration of the Decision to affirm the rejection of claim 6 under 35 U.S.C. 101, and thus, the rejection of claim 6 stands.

V. CONCLUSION

We have carefully considered the arguments raised by Appellant in the Request for Rehearing, but find no points misapprehended or overlooked by the Board in the original Decision and none of these arguments are persuasive that the original Decision was in error. We are still of the view that the invention set forth in claim 6 is unpatentable over the applied prior art as well as under 35 U.S.C. 101 based on the record before us in the original appeal. This Decision on Appellant's Request for Rehearing is deemed to incorporate the earlier Decision (mailed March 23, 2010) by reference. *See* 37 C.F.R. § 41.52(a)(1).

VI. DECISION

We have granted Appellant's request to the extent that we have reconsidered the Decision of March 23, 2010, but we deny the request with respect to making any changes therein.

REHEARING DENIED

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